

BEST AVAILABLE COPY**NOV 22 2006****Remarks**

Claims 21-23 have been added. Claims 1-23 are now pending in the application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Status of the Claims

Pending claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis et al., 6,082,616 ("Lewis"), in view of Berger, U.S. Publication 2002/0022450 ("Berger").

These rejections are respectfully traversed.

**The Applied Reference Does Not Disclose or Suggest
the Features and Relationships Recited in Applicants' Claims**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

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Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

The Lewis Reference

Lewis is directed to an automated banking machine enclosure. The machine includes a keypad mounting plate (62) which attaches to an upper wall (58) through "a tab and slot arrangement" (Column 4, lines 17-21).

The Berger Reference

Berger is directed to Modular Air Vent Assembly Kit that includes L shaped tabs (112) (Figure 1; Paragraph [0048]).

The Pending Claims Are Not Obvious Over Lewis in view of Berger

In the Action pending claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis in view of Berger. These rejections are respectfully traversed.

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Applicants' response to these rejections is based on the Office's referenced interpretation of Lewis. Thus, any change in the Office's interpretation of Lewis shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention.

Claim 1

Claim 1 is an independent claim directed to a cash dispensing automated banking machine. The machine comprises a housing and a cash dispenser. The housing includes at least two sheet metal parts. At least one of the parts includes at least one tab. Also a second one of the parts includes at least one slot. Claim 1 also recites that the at least one tab includes a base portion with at least one groove therein. The groove has a depth which is less than the thickness of the at least one tab. In addition, claim 1 recites that the at least one tab extends through the at least one slot and is bent at the groove to lie adjacent a surface of the second part.

The Action asserts that Lewis shows an ATM that includes sheet metal parts (58) and (62) with tabs and slots. The Action acknowledges that Lewis does not disclose tabs that are grooved. However, the Action asserts that Berger discloses sheet metal tabs (112) with grooves and that it would have been obvious to use the grooved sheet metal tabs as taught by Berger in the invention of Lewis in order to more securely attach the two pieces of sheet metal. Applicants respectfully disagree.

In Berger, the L-shaped tabs (112) are bent from the side walls (26) (Paragraph [0049].

Although a bend is formed, nowhere does Berger teach or suggest a bend in a tab at the location of a groove in the tab. Berger does not disclose or suggest a base portion of at least one tab with at least one groove therein, which at least one groove has a depth which is less than the thickness of the at least one tab. Further, Berger does not disclose or suggest that its tab is bent at the groove to lie adjacent a surface of the second part.

In addition, to form the L-shaped tab in Berger, the L-shaped contour of the tab appears to be cut from the side wall (26). However, even if the Action regards an L-shaped cut in the side wall as corresponding to a groove, such an L-shaped cut does not correspond to the groove as recited in the claim. For example, claim 1 recites that the tab includes a base portion with at least one groove therein. The contour of the L-shaped cut extends around the tab which is formed by the L-shaped cut. The L-shaped cut does not extend in a base portion of a tab and therefore does not correspond to the recited groove. In addition, to enable the L-shaped tab to bend outward from the side wall (26), the L-shaped cut in Berger must extend all the way through the sheet metal of the wall (26). Thus such an L-shaped cut does not have a depth which is less than the thickness of the at least one tab. In addition, when the L-shaped tab is bent away from the side wall (26) the bend is not located at the portion of the wall that is cut, but rather is bent at the portion of the wall that is uncut. Thus the tab in Berger is not bent at the groove.

The applied references do not disclose or suggest each of features and relationships recited in claim 1 and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted

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that claim 1 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 2-9 which depend from claim 1 are likewise allowable.

Claim 11

Claim 11 is an independent claim directed to a method of forming a housing for an automated banking machine which includes a cash dispenser. The method comprises (a) providing at least two sheet metal parts. A first one of the parts includes at least one tab and a second one of the parts includes at least one slot therethrough. The at least one tab includes a groove therein with a depth that is less than the thickness of the at least one tab. The method also comprises (b) inserting the at least one tab into the at least one slot; and (c) bending the at least one tab at the location of the groove to a position adjacent a surface of the second part.

As discussed previously, the Action asserts that Lewis shows an ATM that includes sheet metal parts (58, 62) with tabs and slots. The Action acknowledges that Lewis does not disclose tabs that are grooved. However, the Action asserts that Berger discloses sheet metal tabs (112) with grooves and that it would have been obvious to use the grooved sheet metal tabs as taught by Berger in the invention of Lewis in order to more securely attach the two pieces of sheet metal. Applicants respectfully disagree.

In Berger, the L-shaped tabs (112) are bent from the side walls (26) (Paragraph [0049]. Although a bend is formed, nowhere does Berger teach or suggest a bend in a tab at the location of a groove in the tab. Berger does not disclose or suggest at least one tab that **includes a groove therein, which groove has a depth that is less than the thickness of the at least one**

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tab. Further Berger does not disclose or suggest bending the at least one tab at the location of the groove to a position adjacent a surface of the second part.

In addition, to form the L-shaped tab in Berger, the L-shaped contour of the tab appears to be cut from the side wall (26). However, even if the Action regards an L-shaped cut in the side wall as corresponding to a groove, Such an L-shaped cut does not correspond to the groove as recited in the claim. For example, claim 11 recites that the at least one tab includes a groove therein. The contour of the L-shaped cut extends around the tab which is formed by the L-shaped cut. The L-shaped cut does not extend in a tab and therefore does not correspond to the recited groove. In addition, to enable the L-shaped tab to bend outward from the side wall (26), the L-shaped cut in Berger must extend all the way through the sheet metal of the wall (26). Thus such an L-shaped cut does not have a depth that is less than the thickness of the at least one tab. In addition, when the L-shaped tab is bent away from the side wall (26) the bend is not located at the portion of the wall that is cut, but rather is bent at the portion of the wall that is uncut. Thus Berger does not disclose or suggest bending its tab at the location of a groove.

The applied references do not disclose or suggest each of features, relationships, and steps recited in claim 11 and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features, relationships, and steps that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 11 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 12-18 which depend from claim 11 are likewise allowable.

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Claim 19

Claim 19 is an independent claim directed to a method of forming a housing for an automated banking machine which includes a cash dispenser. The housing includes at least two housing portions. A first portion of the housing includes at least one tab. A second portion of the housing includes at least one slot. The at least one tab includes at least one groove therein. The method includes a step (a) of inserting the at least one tab of the first portion of the housing into the at least one slot of the second portion of the housing. In addition the method includes a step (b) of bending the at least one tab at the location of the groove in the at least one tab to place the first portion of the housing in locking engagement with the second portion of the housing.

As discussed previously, the Action asserts that Lewis shows an ATM that includes sheet metal parts (58, 62) with tabs and slots. The Action acknowledges that Lewis does not disclose tabs that are grooved. However, the Action asserts that Berger discloses sheet metal tabs (112) with grooves and that it would have been obvious to use the grooved sheet metal tabs as taught by Berger in the invention of Lewis in order to more securely attach the two pieces of sheet metal. Applicants respectfully disagree.

In Berger, the L-shaped tabs (112) are bent from the side walls (26) (Paragraph [0049]. Although a bend is formed, nowhere does Berger teach or suggest a bend in a tab at the location of a groove in the tab. Berger does not disclose or suggest at least one tab that includes at least one groove therein. Further Berger does not disclose or suggest bending the at least one tab at the location of the groove in the at least one tab to place the first portion of the housing in locking engagement with the second portion of the housing.

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In addition, to form the L-shaped tab in Berger, the L-shaped contour of the tab appears to be cut from the side wall (26). However, even if the Action regards an L-shaped cut in the side wall as corresponding to a groove, Such an L-shaped cut does not correspond to the groove as recited in the claim. For example, claim 19 recites that the at least one tab includes at least one groove therein. The contour of the L-shaped cut extends around the tab which is formed by the L-shaped cut. The L-shaped cut does not extend in a tab and therefore does not correspond to the recited groove. In addition, when the L-shaped tab is bent away from the side wall (26) the bend is not located at the portion of the wall that is cut, but rather is bent at the portion of the wall that is uncut. Thus Berger does not disclose or suggest bending its tab at the location of a groove.

The applied references do not disclose or suggest each of features, relationships, and steps recited in claim 19 and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests the features, relationships, and steps that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 19 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claim 20, which depends from claim 19, is likewise allowable.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP

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2143.03). *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Thus, it is respectfully submitted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features, relationships, and/or steps that patentably distinguish the claimed invention over the applied art. Neither Lewis nor Berger, taken alone or in combination, discloses or suggests the features, relationships, and/or steps that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features, relationships, and/or steps.

For example, with respect to claims 3-7 and 13-17, Lewis does not disclose or suggest a slot that includes an outwardly bowed portion which provides the slot with a wider center relative to the thickness of the slot at each end.

New Claims

New independent claim 21 is generally similar to claim 1 and recites that the base portion includes a sheet metal thickness and the at least one groove has a maximum depth which is less than the sheet metal thickness. In addition, claim 21 recites that the at least one tab is bent along the entire length of the groove.

New independent claim 22 is generally similar to claim 11 and recites that the at least one tab includes a sheet metal thickness and the groove has a maximum depth that is less than the sheet metal thickness of the at least one tab. In addition, claim 22 recites bending the at least one tab along the entire length of the groove.

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New independent claim 23 is generally similar to claim 19, and recites that the at least one tab includes a sheet metal thickness and the at least one groove has a maximum depth that is less than the sheet metal thickness of the at least one tab. In addition, claim 23 recites bending the at least one tab along the entire length of the at least one groove.

Support for new claims 21-23 is found in the Specification, drawings and the original claims (e.g., Figure 120; Page 48, line 8-11).

None of the cited references alone or in combination discloses or suggests the features, relationships, and steps that are specifically recited in the new claim 21-23. These claims recite features, relationships and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the cited art discloses or suggests the features, relationships and steps that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

Additional Claim Fees

Please charge the fees associated with prosecution of three additional independent claims in excess of 3 (\$600) and any other fee due to Deposit Account No. 09-0428 of Diebold Self-Service Systems.

Conclusion

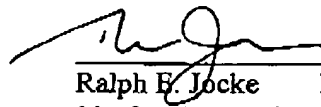
Each of Applicants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the

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applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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